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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,424	12/12/2001	John J. Hart III	ECD-0004	2326

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EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2627

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/023,424

Applicant(s)

HART ET AL.

Examiner

TAN X. DINH

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 and 64-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 2627

1) A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under Ex Parte Quayle, 25 USPQ 74, 453 O.G 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicants submission filed on 4/30/2007 has been entered.

2) The I.D.S filed 2/16/2007 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) The preliminary amendment filed 4/30/2007 is acknowledged. Claims 56-63 have been canceled.

3) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4) Claims 1-55,64-67,76-78,87 and 88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure fails to specify that the steps of "performing a reading operation of the optical medium, the distorted region modifying the reading operation of data stored in the data layer corresponding to the distorted region, such that when data stored in the data layer corresponding to the distorted region is read, a measurable change in system performance of the reading operation results and the ability to perform the reading operation in the distorted region is maintained, the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation, detecting the measurable change in system performance, and authenticating the optical medium based on the measurable change in the system performance" as now claimed in claims 1-55,64-67,76-78,87 and 88. The invention in this instant application is places randomly distortion region on the optical recording medium (disc) in order

Art Unit: 2627

to eliminate the illegal copy. There is no specific teaching how to read and/or perform reading the distortion optical recording medium as claimed.

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

6) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7) Claims 1,29,64,76,87 and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by GERMAN PATENT OFFICE (DE 196 02 804 A1, publication on July 31 1997).

The GERMAN PATENT OFFICE (DE 196 02 804 A1) discloses a method for determining authenticity of an optical recording medium as claimed in claims 1,64 and 87, comprising the steps of:

modifying an optical path of the optical medium, the optical medium including a first layer adjacent a data layer, the modifying of the optical path of the optical medium includes selecting a region of the first layer to be distorted (See the translation, page 2, paragraph (2));

prior to a reading operation of the medium, distorting the region of the first layer, the distorted region extending in a

Art Unit: 2627

direction along a track of the data layer (See the translation, page 2, paragraph (2));

performing a reading operation of the optical medium, the distorted region modifying the reading operation of data stored in the data layer corresponding to the distorted region, such that when data stored in the data layer corresponding to the distorted region is read, a measurable change in system performance of the reading operation results and the ability to perform the reading operation in the distorted region is maintained, the distorted region maintaining its optical characteristics following . irradiation of the distorted region during the reading operation (See the translation, page 2, paragraph (3). In this case, the test/scan program capable of suppressing any errors occur during scanning the distortion region, the test/scan program is included in the software, see paragraph (5));

detecting the measurable change in system performance and authenticating the optical medium based on the measurable change in the system performance (See the translation, page 2, paragraphs (4) and (5)).

Claims 29,76 and 88 are drawn to the optical recording medium corresponding to the method of using same as claimed in claims 1,64 and 87. Therefore, optical recording medium claims are rejected for

Art Unit: 2627

the same reasons of anticipation (obviousness) as used above.

8) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10) Claims 2-28, 30-55, 65-75, 79-86 (*remaining claims*) are rejected under 35 U.S.C. 103(a) as being unpatentable over GERMAN PATENT OFFICE (DE 196 02 804 A1, publication on July 31 1997).

The GERMAN PATENT OFFICE (DE 196 02 804 A1) discloses a

Art Unit: 2627

method for modifying an optical path of an optical medium, as claimed in claim 68, comprises the steps of selecting a region of the first layer to be distorted (See the translation, page 2, paragraph (2)), and prior to a reading operation of the medium, distorting the region of the first layer such that a reading operation of data stored in the data layer corresponding to the distorted region is modified, the distorted region extending in a direction along a track of the data layer, the distorted region maintaining its optical characteristics following irradiation of the distorted region during the reading operation (See the translation, page 2, paragraph (3). In this case, the test/scan program capable of suppressing any errors occur during scanning the distortion region, the test/scan program is included in the software, see paragraph (5)), *except to specifically show that* the distortion region comprises convex feature. It would have been obvious to someone within the level of skill in the art at the time of the invention was made to make distortion region as convex feature in the GERMAN PATENT OFFICE (DE 196 02 804 A1) as claimed. The rationale is as follows:

The GERMAN PATENT OFFICE (DE 196 02 804 A1) suggests in the translation, page 2, paragraph (2) that the distortion region can be made with laser beam, hot point object or simply scratch the

Art Unit: 2627

surface with scalpel. This damage and above all the shape, size and locally thereof should be defined randomly. Obviously, one of ordinary skill in the art at the time of the invention was made would have been motivated to make the distortion region of the GERMAN PATENT OFFICE (DE 196 02 804 A1) as convex feature, concave feature or any suitable features in order to distort the reading signals during reproducing process.

Claim 79 is drawn to the optical recording medium corresponding to the method of using same as claimed in claims 68. Therefore, optical recording medium claims are rejected for the same reasons of anticipation (obviousness) as used above.

Claims 2-28,30-55,65-67,69-75,77,78,80-86 recite various features of locating the distortion regions on inner area, outer area, between layers, formed distortion regions as indentations, etc., are deemed obvious to someone within the level of skill in the art since all of these features are just modified the teaching of GERMAN PATENT OFFICE (DE 196 02 804 A1) as shown in the translation, pages 2 and 3.

11) Applicant's arguments filed 4/30/2007 have been fully considered but they are not persuasive.

The translation of GERMAN PATENT OFFICE (DE 196 02 804 A1), page 2, paragraphs (3) and (5) includes a test/scan program for

Art Unit: 2627

scanning the distortion regions and maintaining the reading operation for detecting the illegal copy of the recording medium (see paragraphs (3), (4) and (5)). For that reasons, the claims are still rejectable as shown above.

12) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

13) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN XUAN DINH whose telephone number is (571)272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 9:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

Art Unit: 2627

for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAN DINH
PRIMARY EXAMINER

May 24, 2007